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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/217,112	12/21/1998	KYOU-WOONG KIM	678-206-(P85	8740

7590 04/27/2004

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EXAMINER
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CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 04/27/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/217,112

**Applicant(s)**

KIM, KYOU-WOONG

**Examiner**

WILLIAM D. CUMMING

**Art Unit**

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Schroder, et al.**

Schroder, et al disclose a composite cellular telephone (figure 1) for generating a unique incoming call alert tone and/or display ("A distinctive signaling method useful in a dual-mode or tri-mode cellular phone system that incorporates both voice call functionality and data messaging functionality. Distinctive signaling is used to distinguish incoming voice calls from incoming data messages, and further to distinguish between various different data message types by examining header information in a received data message.") responsive to a paging message received over a cellular system (" This invention relates to electronic cellular telephone systems, and more particularly to an improved user interface for a cellular telephone system subscriber unit"). The received paging message having at least two recognized service options available via the cellular system (" Another aspect of the present invention useful in a dual-mode or tri-mode cellular phone system that incorporates both voice call functionality and data messaging functionality is an improved form of distinctive signaling. In prior art land line telephone systems, distinctive signaling provides a unique auditory signal on one telephone to indicate incoming calls from one of several input lines. In the present

context, distinctive signaling is used to distinguish incoming voice calls from incoming data messages, and further to distinguish between various different possible types of data messages"). The composite cellular terminal (figure 1) comprising means for setting and storing the unique incoming call alert and/or display for each of the at least two service options (figure 1B, #20, 21, 22, 23, etc.). Means for recognizing a service option from a received paging message and means for retrieving an incoming call alert tone and/or display corresponding to the recognized service option (" A flowchart of the inventive distinctive signaling method is shown in FIG. 7. The cellular telephone 1 receives an incoming call in conventional fashion (STEP 700). If the call is a conventional analog voice call (e.g., from an AMPS system), the telephone 1 will use conventional analog voice circuitry to receive that call. Since only the voice circuitry is activated, it can be determined that the incoming call is voice and not data (STEP 702). Further, it can be determined whether an incoming voice call is associated with a particular NAM ("Number Assignment Module"). This is done in known fashion by monitoring the analog voice system control channel. Consequently, a different indicator can be associated with each NAM available within a cellular telephone unit 1 (STEP 704). The indicator may be, for example, auditory (such as conventional distinctive ringing), vibratory (to give a tactile indication to a user without being conspicuous), visual (such as different blinking patterns or messages in the display 11), or any combination of the above, such that the indicator associated with a particular NAM is distinctive.

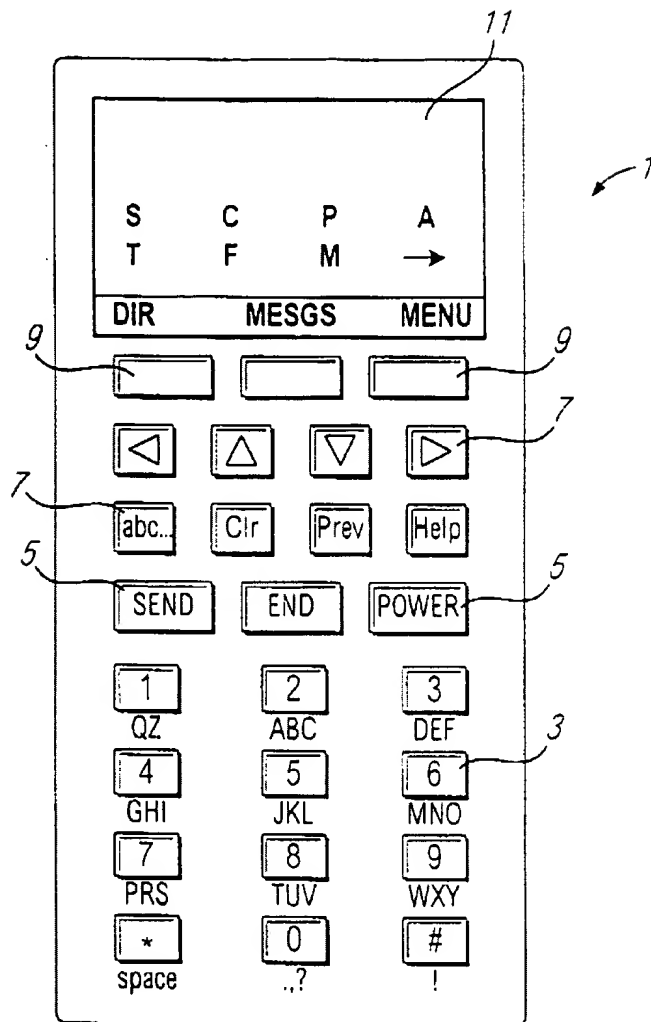


FIG. 1A

"If the incoming call is not a voice call, but is instead a data call, the header of the data packet (such as the header of a conventional CDPD data packet) is examined to determine the message type (STEP 706). For example, the preliminary (May 5, 1995) Protocol Specification for a Short Message Service Over CDPD ("SMS-CDPD"), published by the assignee of the present invention and herein incorporated by reference, specifies one header structure that can be used by the present invention. As one example, only, the SMS-CDPD protocol specifies an application layer header having a code that indicates that an incoming message is a pager call, a

voice mail notification call, or a data message call. Other information that may be stored in an incoming data packet may include the address, source, and/or class of the message. Accordingly, since each message can be distinguished by type and/or by source, a distinctive indication can be associated with each such message type to alert the user not only that a data message call has been received, but the nature of the message (STEP 708). Again, as described above, the indicator associated with a particular message type may be auditory, vibratory, visual, or a combination of the above."). Means for generating the retrieved incoming call alert tone and/or display (#26, 25, 23, 20).

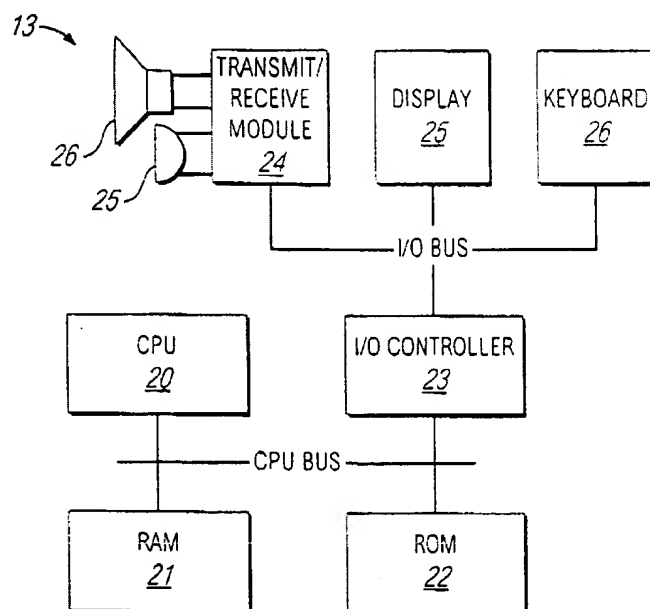


FIG. 1B

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "*inherent*" or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable

interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). It was held in In re Donohue, 226 USPQ 619, that, "*It is well settled that prior art under 35 USC §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention.*" Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be "*given the broadest reasonable interpretation consistent with the specification.*" Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "*heavy presumption*" that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969).

Newton's telecom Dictionary, 8<sup>th</sup> edition, defines a paging (to give a message to someone who is somewhere) and message (a sequence of characters used to convey information or data).

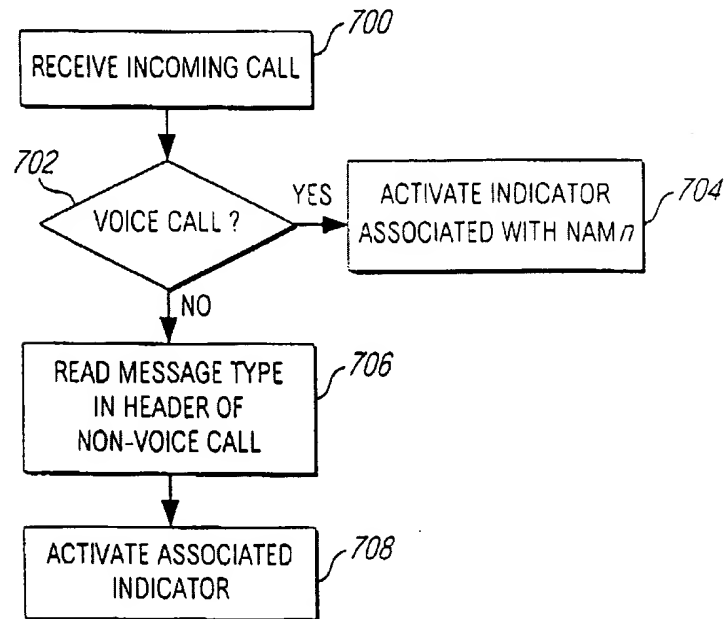


FIG. 7

***Allowable Subject Matter***

3. Claims 1-8 are allowed.
4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).



***Response to Arguments***

5. Applicant's arguments with respect to claims 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

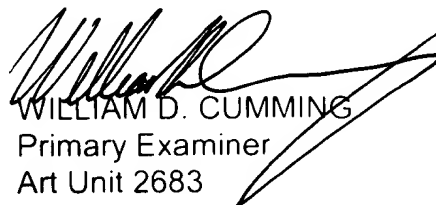
**Thompson, et al, Tanka, et al, Obayashi, et al, Jambheker, et al, Barber, et al, Gallant, et al, and Henry, et al** disclose a composite cellular telephone for generating a unique incoming call alert tone and/or display responsive to a paging message received over a cellular system.

7. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is **703-305-4394**. The examiner can normally be reached on Wednesday and Thursday, 9:30am to 7:00pm, EST.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
WILLIAM D. CUMMING  
Primary Examiner  
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